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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,896	07/03/2003	Donald Alan Bistline	Don1	2965

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EXAMINER
GALL, LLOYD A

ART UNIT	PAPER NUMBER
3676	

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/613,896	BISTLINE, DONALD ALAN	
	Examiner	Art Unit	
	Lloyd A. Gall	3676	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 December 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) *8,10 and 13-16* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7,9,11 and 12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *7/3/03 and 12/14/05* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-7, 9, 11 and 12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 10/685,662. Although the conflicting claims are not identical, they are not patentably distinct from each other because they substantially claim the same subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 7, 9, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by the PCT reference (660).

The PCT reference teaches an apparatus for mounting a surfboard to a vehicle, including a mounting bracket shown directly below the shackle 3 in figure 8, which mounting bracket receives the screws 14, 15, a mating unit 1 removably secured to the mounting bracket, the mating unit including an adjustable shackle 3, 7 and a mating portion 1, and a locking mechanism (2 or 50, and means 14, 15 for removably securing the mating portion 1 to the mounting bracket. The means 14, 15 includes a pin 14, 15 received in first 10 and second 11 apertures. The pins 14, 15 are inaccessible when the surfboard is installed. The mounting bracket as seen in figure 8 includes a rear planar surface which faces the vehicle, and opposite upper and lower side portions extending upwardly therefrom. Cushions 12 and 13 are also included. With respect to claim 12, it is noted that a snowboard is not positively claimed, and that the PCT reference is capable of receiving a snowboard.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over the PCT reference (660) in view of Kemery et al.

Kemery teaches a shackle 10 for locking a snowboard. It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute a snowboard for the surfboard of the PCT reference, in view of the teaching of Kemery, the motivation being to prevent theft of a snowboard when it is not in use.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over the PCT reference (660) in view of Mareydt et al.

Mareydt teaches a slotted lower surface in element 15 of a mounting bracket to receive a tabbed lower surface of a mating unit 46. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include interengaging tab(s) and slot(s) with the mounting bracket and mating unit of the PCT reference, in view of the teaching of Mareydt, the motivation being to provide a strong connection therebetween.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the PCT reference (660) in view of Wroble.

It is noted that a fin removal mechanism and a fin are not being positively claimed, and that Wroble teaches a fin guard 350 in fig. 5B which is capable of covering a fin removal mechanism. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a fin guard with the shackle of the PCT reference, in view of the teaching of Wroble, the motivation being to prevent tampering and theft of a removable fin.

Applicant's arguments filed September 12, 2005 have been fully considered but they are not persuasive. In response to applicant's remarks which are centered around

the PCT reference, with respect to the last three lines of page 7 of the remarks, it is noted that with respect to the "one half" argument, it is noted first that the claims set forth an adjustable shackle, and not a shackle including first and second halves. It is further noted that adjustable locking shackles come in many types, such as straps, pivoted shackles, and slidable shackles, such as taught by the PCT reference (660). Portions 3 (which is fixedly secured to the mating portion 1, as claimed) and 7 of the shackle of the PCT reference clearly teach an adjustable shackle as claimed.

In response to the arguments on page 8 concerning the PCT reference, it is submitted that the mating unit 1 of the PCT reference is clearly capable of being removed from the mounting bracket, and the "permanently attached" description of the PCT reference is a relative term, in relation to the removable, adjustable shackle. This removability requires only well known removable fasteners, such as screws. Further, it would seem very unlikey that one would never want to remove the mating unit of the PCT reference, such as when one would not want to use the unit, or to clean the vehicle.

In response to applicant's argument on page 8, line 17, it is submitted that the "roof rack" referred to by applicant may be regarded as the claimed mounting bracket.

The remainder of applicant's remarks do not take issue with the secondary references, and what they were relied on for as teaching.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lloyd A. Gall whose telephone number is 571-272-7056. The examiner can normally be reached on Monday-Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571-272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LG LG
March 3, 2006

Lloyd A. Gall
Primary Examiner